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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/845,323	03/03/92	WICK	S 43682USA5C

EXAMINER
HENLEY III, R

3M OFFICE OF INTELLECTUAL PROP. COUNSEL
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ART UNIT	PAPER NUMBER
1205	C

DATE MAILED 11/13/92

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 8/25/92 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-15, 32 and 33 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1-15, 32 and 33 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).

12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

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Claims 1-15, 32 and 33 are presented for examination.

Applicants' amendment and the affidavit of Stephen Berge filed August 25, 1992 have been received and entered into the application. Accordingly, claims 16-31 have been canceled.

Claims 1-15, 32 and 33 remain rejected under 35 U.S.C. § 103 as being unpatentable over Gerster in view of Mahjour et al. and the combination of Kigasawa et al. and Lachman, each of record for the reasons of record as set forth at pages 2-5 of the last Office action dated May 21, 1992.

Applicants' arguments and the Berge affidavit have been given careful consideration but fail to persuade the Examiner of error in his determination of obviousness.

Applicants aver that the affidavit serves to refute the contention that the selection of fatty acids is a matter of choosing from obvious alternatives. The Examiner however, cannot agree.

The affidavit demonstrates results that would have been expected for the use of oleic acid as a penetration enhancer given the explicit disclosure by Mahjour et al. at column 3, lines 11-13.

Respecting the results obtained with isostearic acid, the Examiner will agree that unexpected results are demonstrated in view of Mahjour et al.'s generic teaching of all C₈₋₂₄ saturated and unsaturated fatty acids as being effective transdermal

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penetration enhances and affiants showing that out of the group of isostearic, stearic and palmitic acids, only isostearic acid provided effective. However, this showing fails to provide a sufficient basis for concluding that the claimed subject matter would have been nonobvious because:

(1) The results demonstrated pertain to the method in which the ingredients were manipulated rather than to any physical and/or structural characteristics of a composition containing them. Thus, claims 1-15 which delineate compositions are not seen to be patentable.

(2) Claims 32 and 33 are neither limited to transdermal administration nor to isostearic acid as the penetration enhancer.

For these reasons, it is maintained that applicants' claims 1-15, 32 and 33 are drawn to subject matter that would have been no more than prima facie obvious and are thus properly rejected under 35 USC 103.

None of the claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE

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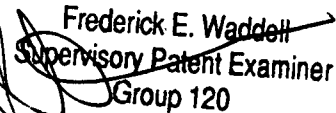
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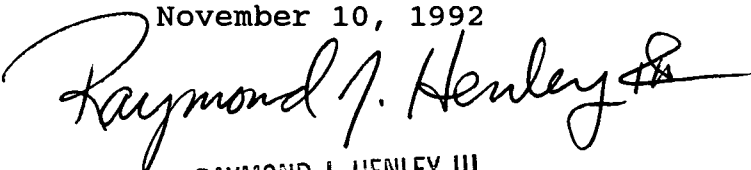
ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Ray Henley whose telephone number is (703) 308-4652.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.


Frederick E. Waddell
Supervisory Patent Examiner
Group 120

HENLEY:tce
November 10, 1992


RAYMOND J. HENLEY III
PATENT EXAMINER
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